

REMARKS

Claims 1 to 44 are pending in the application.

Claims 12 to 14, and 38 are original.

Claims 3, 4, 10, 11, 15 to 21, 26, 27, 29, 32, 35, 43, and 44 are currently amended.

Claims 1, 2, 5 to 9, 22 to 25, 28, 30, 31, 33, 34, 36, 37, and 39 to 42 are cancelled.

Claims 3, 4, 10 to 21, 26, 27, 29, 32, 35, 38, 43, and 44 would be all of the claims pending in the application if the amendment in this paper is entered.

Discussion of Amendments

Support for the amendment of Claims 3 and 32 is found in the specification, including on page 6, at lines 5 to 9. Support for the definitions of the terms “substituted C₁-C₆ alkyl,” “substituted aryl,” “substituted heteroaryl,” “substituted C₂-C₆ alkenyl,” “substituted C₂-C₆ alkynyl,” and “substituted carbocycle” are found in the specification, including the following passages:

substituted C₁-C₆ alkyl: page 42, at lines 17 and 18, and page 44, at lines 6 to 12;

substituted aryl: page 45, at lines 16 to 24;

substituted heteroaryl: page 45, at line 29, to page 46, at line 7;

substituted C₂-C₆ alkenyl: page 43, at lines 6 to 8, and page 44, at lines 6 to 12;

substituted C₂-C₆ alkynyl: page 43, at lines 9 to 12, and page 44, at lines 6 to 12; and

substituted carbocycle: page 43, at lines 13 to 16.

Certain species of Claims 10 and 35 have been deleted, as the deleted species are not embraced by the subject matter of the elected invention.

Applicant believes that the subject matter of the above claim listing is within the subject matter of the elected invention. Applicant retains all rights to reintroduce cancelled or deleted subject matter in the claims in the present application or in any continuation, divisional, and continuation-in-part applications thereof.

Claim Rejections - 35 U.S.C. § 112

In item 2 of the Office Action, Claims 1 to 3, 7 to 9, 11 to 14, 21 to 32, 34, and 36 to 44 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In item 2(a), Claims 1 to 3, 11 to 14, 30 to 32, and 34 recite the word “substituted” in front of the moiety (e.g., substituted C₁-C₆ alkyl and substituted C₂-C₆ alkenyl, etc.), which allegedly renders indefinite those claims because there are no substituents listed for those “substituted” moieties.

Applicants respectfully traverse the rejection on the grounds that Claims 1, 2, 7 to 9, 22 to 25, 28, 30, 31, 34, 36, 37, and 39 to 42 are canceled, rendering the rejection of Claims 1, 2, 7 to 9, 22 to 25, 28, 30, 31, 34, 36, 37, and 39 to 42 moot, and that the definitions of the moieties having the word “substituted” have been expressly added to Claims 3, 11, and 32, and thus to Claims 12 and 13, which depend from Claim 11.

In item 2(b) of the Office Action, Claims 21 to 29 and 36 to 44 carry over the limitation of the word “substituted” in front of the moiety (e.g., substituted C₁-C₆ alkyl and substituted C₂-C₆ alkenyl, etc.) because they are dependent on Claims 1 or 30 to 34.

Applicants respectfully traverse the rejection on the grounds that Claims 1, 22 to 25, 28, 30, 31, 34, 36, 37, and 39 to 42 are canceled, rendering the rejection

of Claims 22 to 25, 28, 36, 37, and 39 to 42 moot, and that the definitions of the moieties having the word “substituted” have been expressly added to Claims 3, 11, and 32, and thus to Claims 21, 26, 27, 29 and 38, 43, and 44, which depend therefrom.

In item 3 of the Office Action, Claims 22 to 25, 28, 41, and 42 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for the method of treating inflammation, rheumatoid arthritis, and osteoarthritis, allegedly does not reasonably provide enablement for other diseases that are related to MMP-13.

Applicants respectfully traverse the rejection on the grounds that Claims 22 to 25, 28, 41, and 42 are canceled, rendering the rejection of Claims 22 to 25, 28, 41, and 42 moot.

Applicants point the Examiner to the Office Action mailed June 16, 2003, in U.S. Patent Application No. 10/264,764, which is cited in the enclosed supplemental Information Disclosure Statement, and suggest that further examination of Claims 27 and 43 may be necessary.

Claim Rejections - 35 U.S.C. § 102

In item 4 of the Office Action, Claims 1 to 3, 8, 9, 21, 30, and 36 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Furrer et al. (DE 41 37 437). Furrer et al. allegedly disclose in Table 1 several compounds (e.g., compound nos. 3, 5, 7, 16, 17, and 24) that read on the rejected claims.

Applicants traverse the rejection on the grounds that Claims 1, 2, 8, 9, 30, and 36 are canceled, rendering the rejection of Claims 1, 2, 8, 9, 30, and 36 moot, and that the 2- and 3-positions of the thiazolo-pyrimidine ring in the compounds of Furrer et al. are CH₂ groups, whereas the thiazolo[3,2-c]pyrimidine compounds

of Claims 3 and 21 do not have CH₂ groups at the 2- or the 3-position (i.e., at the ring carbon bonded to R² or R³, respectively) of the thiazolo[3,2-c]pyrimidine ring. Accordingly, Applicants believe that Claims 3 and 21 are not anticipated by Ferrer et al. and that Claims 3 and 21 are patentable under 35 U.S.C. § 102(b) in view of Ferrer et al.

In item 5 of the Office Action, Claims 1 to 3, 8, 9, 21, 26, 27, 29, 30, and 36 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Naka et al. (U.S. 5,082,838). Naka et al. allegedly disclose several compounds (e.g., columns 23 and 24, compound nos. 2, 4, 5, etc.; columns 29 and 30, compound no. 47; and columns 41 and 42, compound nos. 95 to 97) that read on the rejected claims.

Applicants traverse the rejection on the grounds that Claims 1, 2, 8, 9, 30, and 36 are canceled, rendering the rejection of Claims 1, 2, 8, 9, 30, and 36 moot, and that the 2- and 3-positions of the thiazolo-pyrimidine ring in the compounds of Naka et al. are CH₂ groups, whereas the thiazolo[3,2-c]pyrimidine compounds of Claims 3, 21, 26, 27, and 29 do not have CH₂ groups at the 2- or the 3-position of the thiazolo[3,2-c]pyrimidine ring. Accordingly, Applicants believe that Claims 3, 21, 26, 27, and 29 are not anticipated by Naka et al. and that Claims 3, 21, 26, 27, and 29 are patentable under 35 U.S.C. § 102(b) in view of Naka et al.

In items 6, 7, or 8 of the Office Action, Claims 1 to 3, 8, 21, 30, and 36 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kaul et al. (J. Pharm. Sci. 1982;71(8):897-900), Kaul et al. (Xenobiotica 1982;12(8):495-498), or Kaul et al. (Arzneim.-Forsch/Drug Res. 1982;32(I)(6):610-612), respectively. The Kaul et al. references allegedly disclose metabolite no. 4 on page 900, compound VI on page 496, or compound VI on page 611, respectively, that allegedly read on the rejected claims. The same claims are rejected in items 6, 7, and 8 of the Office Action and the compound of each Kaul et al. reference is the

same compound. Accordingly, Applicants address all three rejections together below.

Applicants traverse the rejection on the grounds that Claims 1, 2, 8, 30, and 36 are canceled, rendering the rejection of Claims 1, 2, 8, 30, and 36 moot, and that the 2- and 3-positions of the thiazolo-pyrimidine ring in the compounds of the Kaul et al. references each are CH(CH₂OH) and CH₂ groups, respectively, whereas the thiazolo[3,2-c]pyrimidine compounds of Claims 3 and 21 do not have CH(CH₂OH) or CH₂ groups, respectively, at the 2- or the 3-position of the thiazolo[3,2-c]pyrimidine ring. Accordingly, Applicants believe that Claims 3 and 21 are not anticipated by any of the Kaul et al. references and that Claims 3 and 21 are patentable under 35 U.S.C. § 102(b) in view of any of the Kaul et al. references.

In item 9 of the Office Action, Claim 30 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tsuge et al. (Tetrahedron 1972;28:4737-4746). Tsuge et al. allegedly disclose compound no. 27 on page 4742 that reads on the rejected claims.

Applicants traverse the rejection on the grounds that Claim 30 is canceled, rendering the rejection of Claim 30 moot.

Claim Objections

In item 10 of the Office Action, Claims 4, 10, 15 to 20, and 35 are objected to as allegedly being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully traverse the objection on the grounds that the rejections of the base claim(s) have been overcome for the reasons provided

above and in view of the current amendments to Claims 4, 10, 15 to 20, and 35, and therefore Claims 4, 10, 15 to 20, and 35 are allowable.

Supplemental Information Disclosure Statement

Applicant herewith makes available to the Patent and Trademark Office a supplemental Information Disclosure Statement ("IDS") on forms PTO/SB/08A and/or PTO/SB/08B and copies of the art cited thereon except any U.S. patent or patent application publication documents.

Applicant respectfully requests that the Examiner consider carefully the complete text of the cited reference(s) in connection with the examination of the above-identified application in accord with 37 CFR §1.104(a).

It is respectfully requested that all cited reference(s) considered by the Examiner be listed in the "References Cited" portion of any patent issuing from the instant application (MPEP § 1302.12).

Conclusion

In view of the above amendments and remarks, Applicants believe that the rejection of Claims 1 to 3, 7 to 9, 11 to 14, 21 to 32, 34, and 36 to 44 under 35 U.S.C. § 112, second paragraph, the rejection of Claims 22 to 25, 28, 41, and 42 under 35 U.S.C. § 112, first paragraph, the rejection of Claims 1 to 3, 8, 9, 21, 26, 27, 29, 30, and 36 under 35 U.S.C. § 102(b), and the objection to Claims 4, 10, 15 to 20, and 35 have been overcome. Applicants respectfully requests reconsideration of Claims 3, 4, 11 to 21, 26, 27, 29, 32, 35, 38, 43, and 44.

The undersigned would welcome a telephone call from the Examiner to discuss any matters related to this case that the Examiner thinks are amenable to resolution by such discussion.

10/071,032

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Respectfully submitted,

Date: August 18, 2004

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